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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

PHIL-TAE KIM

Serial No.: 09/419,300 Examiner: ABDULSELAM, ABBAS

Filed: 15 October 1999 Art Unit: 2674

(CPA Application filed on 22 May 2002)

For: METHOD FOR CONTROLLING POSITION OF INDICATOR

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PETITION UNDER 37 C.F.R. §1.181

Mail Stop: Petition
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully request reconsideration and withdrawal of the finality of the rejection of the last Office action (Paper No. 22) mailed on 4 August 2003, and as reasons therefore states that:

Folio: P55862
Date: 10/3/03
I.D.: REB/SS/sb

STATEMENT OF FACTS

1. Applicant filed a patent application on 15 October 1999 setting forth claims 1-17.

2. The U.S. Patent and Trademark Office mailed a non-final Office action on 28 June 2001 (Paper No. 6). The Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630) in Paper No. 6.

3. Applicant filed an Amendment on 28 September 2001. The Amendment filed on 28 September 2001 did not include any amendments of the claims 1-17.

4. The U.S. Patent and Trademark Office mailed a final Office action on 17 December 2001 (Paper No. 9). Claims 1-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630) in Paper No. 9.

5. Applicant filed an Amendment on 6 March 2002. The Amendment filed on 6 March 2002 included amendments to claims 8 and 17, and simply responded to the issues raised in the Paper No. 9, and no new issues were raised.

6. The U.S. Patent and Trademark Office mailed an Advisory Action on 25 March 2002 (Paper No. 12).

7. An IDS with petition was filed on 1 April 2002.

8. Applicant filed a Continued Prosecution Application (CPA) with a Preliminary Amendment on 22 May 2002. Claims 8 and 17 were amended, and claims 18-23 were newly added in the Preliminary Amendment filed on 22 May 2002.

9. The U.S. Patent and Trademark Office mailed a non-final Office action on 14

August 2002 (Paper No. 18). The Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630) in Paper No. 18.

10. Applicant filed an Amendment on 14 November 2002. Claim 1 was amended.

11. The U.S. Patent and Trademark Office mailed a non-final Office action on 29 January 2003 (Paper No. 20). The Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630) and Choi (U.S. Patent No. 5,648,781) in page 2 of Paper No. 20.

12. Applicant filed an Amendment on 22 April 2003. Claims 3 and 8 were amended and claim 24 was newly added. The Applicant respectfully believes that the remarks included in the Applicants' Amendment filed on 22 April 2003 were fully responsive to all of the issues discussed in Paper No. 20. The Applicant respectfully traverses the rejection of claims 1-23, and the Applicant respectfully explained why the §103 rejection of claims 1-23 is believed to be improper, in detail, in the Amendment filed on 22 April 2003.

13. The U.S. Patent and Trademark Office mailed a final Office action on 4 August 2003 (Paper No. 22). The Examiner rejected claims 1-3 and 18-24 under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Choi (U.S. Patent No. 5,648,781) in page 3 of Paper No. 22. Also, the Examiner rejected claims 4-17 under 35 U.S.C. § 103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Choi (U.S. Patent No. 5,648,781) and

Miyashita (U.S. Patent No. 6,186,630) on page 4 of Paper No. 22.

REMARKS

The Applicant respectfully believes that the final Office action mailed on 4 August 2003 (Paper No. 22) is a premature final Office action for the following reasons.

The Applicant respectfully believes that the final Office action mailed on 4 August 2003 (Paper No. 22) is a premature final Office action because Paper No. 22 includes new grounds for rejections for claims 1-3 and 17-23, when the claims 1, 2 and 17-23 were not amended by the Applicant, the amendment to claim 3 did not necessitate the new ground of rejection and the new grounds for rejections were not based on any information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The *Manual of Patent Examining Procedure* (MPEP) §706.07(a) states "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Therefore, the MPEP § 706.07(a) indicates that a second action on the merits ***will not be***

made final if it includes a new ground for rejection of any claim not amended by applicant or if the amendment does not necessitate the new ground for rejection in spite of the fact that other claims may have been amended or added to require a new ground for rejection. The new grounds for rejection are looked at claim by claim.

Furthermore, the definition of "a new ground for rejection" does not only refer to newly cited references, but to the below mentioned new grounds for rejection as MPEP 706.07(a) specifically mentions the case of newly cited references separately from "a new ground for rejection" afterwards as "Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art."

The Applicants filed a patent application on 15 October 1999 setting forth claims 1-17, a non-final office action was made on 28 June 2001 (Paper No. 6), and a final office action was made on 17 December 2001 (Paper No. 9). Then a Continued Prosecution Application (CPA) was filed on 22 May 2002 setting forth claims 1-22. The U.S. Patent and Trademark Office mailed a non-final Office action on 14 August 2002 (Paper No. 18), in which the Examiner rejects claims 1-23 under 35 U.S.C. § 103(a) as being as being unpatentable over by U.S. Patent No. 5,350,967 issued to Sakurai (Sakurai '967) in view of U.S. Patent 6,186,630 issued to Miyashita (Miyashita

'630). The Applicant filed a response on 14 November 2003 and amended claim 1. Subsequently, the U.S. Patent and Trademark Office mailed a non-final Office action on 29 January 2003 (Paper No. 20), wherein the Examiner relies upon a combination of Sakurai '967, Miyashita '630 and a third newly cited reference, U.S. Patent No. 5,648,781 issued to Choi (Choi '781), to reject the claims 1-23 under 35USC§103(a). The Applicant filed a response on 22 April 2003 amending claims 3, 8 and adding new claim 24. Subsequently, the U.S. Patent and Trademark Office mailed a final Office action on 04 August 2003 (Paper No. 22), wherein the Examiner relies upon a new combination of Sakurai '967 and Choi '781 to reject claims 1-3 and 18-24 and claims 4-17 are rejected under the combination of Sakurai '967, of Choi '781 and Miyashita '630 under 35USC§103(a).

The Applicant respectfully believes that the remarks included in the Applicant's response filed on 22 April 2003 were fully responsive to all of the issues discussed in Paper No. 20. For example, in the Applicants' response, the Applicants respectfully traverse the rejection of claims 1-23, and the Applicant respectfully explain why the § 103 rejection of claims 1-23 is believed to be improper, in detail, on pages 9-14 of the response filed on 22 April 2003.

The rejection of claims 1-24 in Paper No. 22 includes a new ground of rejection because, first, the rejection for claims 1-3 and 18-23 are based on a new combination of Sakurai '967 and Choi '781 as mentioned on page 3 of paper number 22, while in the previous office action (paper No. 20), the Examiner rejected claims 1-3 and 18-23 based on a different combination of Sakurai '967, of Choi '781 and also Miyashita '630, while also in the Examiner's arguments, the Examiner

only uses only the combination of Sakurai '967 and Miyashita '630 in rejecting claims 1-3 and 18-23. The combination of Sakurai '967 and Choi '781 is never used in the rejection of claims 1-3 and 18-23 in paper number 20 while in paper number 22 the Examiner uses this combination of references.

After the Examiner received the Applicant's response filed on 22 April 2003, the Examiner relied upon the new ground of rejection to reject the claims 1-3 and 18-23, even though the claims 1, 2 and 18-23 were not amended and claim 3 was only amended to correct "said display" to "a display". Therefore, the amendment to claim 3 does not necessitate the new ground of rejection for claim 3 and claims 1, 2 and 18-23 were never amended. Furthermore, the new grounds of rejections were not necessitated by the amendment.

Specifically, the new grounds for rejection are also evidenced by the following:

On page 2 of paper number 22, the Examiner uses Sakurai (USPN 5581685) teaching "the display of current menu (S28), the selection for displaying a sublevel menu (S29 or a step S31) and a selection process that may be performed by control code keys, function keys etc. See col. 2, lines 64-67 and col. 3, lines 1-13." The above argument is from the background art of Sakurai which was never mentioned in the previous office action of paper number 20.

For example in paper number 20, the Examiner mentioned specifically Sakurai and Miyashita only concerning claim 1 which was not amended and the present office action of paper number 22, the Examiner used Sakurai and Choi instead.

In another example, concerning claim 1 which was not amended in any way, the Examiner in paper number 22 stated that Sakurai does not teach automatically adjusting the area indicator to be located within the submenu but that Choi teaches locating a cursor (32) on the desired submenu icon. For example, the Examiner stated that a cursor appearing on a main menu icon (30) is relocated and displayed on a submenu (34). See col. 3, lines 14-26 and Fig. 2(C-D). This ground of rejection was not made earlier in paper number 20.

Another example is claim 17 which was not amended, the Examiner stated that "Choi teaches the use of a remote control method for performing remote controlling of a television in which menu icons having predetermined control contents are utilized. Choi teaches the use of main menu, submenu, and the cursor that are displayed on the screen of the television (col. 1, lines 48-57). Choi further teaches displaying the menu icons and selecting the desired menu icon as well as displaying cursor on the screen and the cursor being initially displayed on a predetermined position of the screen according to the X, Y coordinates. See col. 1, lines 49-67. Moreover, referring to Fig. 3, Choi teaches a remote controller (50) including a trackball (54), a trackball movement sensing means (56) for sensing the movement of the trackball (54) as position shift value, a shift value data storage unit (58)for storing data with respect to the position shift values in advance, control commander (62) for selecting the menu icon which is displayed on the screen where the cursor is located, data generator (60) for generating the data corresponding to the sensed position shift value from shift value data storage unit (58) and transmitter (64) for coding and transmitting the data generated by data generator (60). Choi also teaches a television (52) including a receiver (66) for receiving the signal transmitted from the transmitter (64), menu display circuit

(68) for displaying various menus of the television and the menu storage (70) for storing menus, submenus and control modes, a cursor display circuit (72) for displaying the cursor according to the movement of the trackball and content execution unit (74) for executing the function of the selected icon where the cursor is located."

Concerning claim 17, in paper number 20, page 3, however, the Examiner earlier stated that "Miyashita teaches about operating section(400), trackball (28a), menu button (22e, 22j), adjust button (28c), freeze button (22d) and other functions (24a, 24b, 24c). See figure 3. Furthermore, Miyashita teaches about wireless receiver means (14a, 14b) with limited receiving ranges." Clearly the grounds for rejection are new in paper number 22 as compared to paper number 20 for claim 17 since paper number 20 used the combination of Miyashita '630 and Sakurai '967 and in paper number 21 the combination of Choi '781 and Sakurai '967 was used in the rejection.

None of the above grounds for rejection were mentioned before the final rejection of paper number 22.

Moreover, the Applicant under due process concerns should be given proper opportunity to address any new ground for rejection that is not necessitated by the Applicant's amendment or an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p).

For all of the foregoing reasons, the Applicant respectfully believes that the Paper No. 22 is a premature final Office action because of the new grounds for rejection of claims 1-3 and 17-23

that were not necessitated by amendment nor based on information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p).

RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

A. Reconsider the finality of the rejection of the last Office action (Paper No. 22);

B. Withdraw the finality of the last Office action (Paper No. 22); and

C. Grant such other and further relief as justice may require.

Respectfully submitted,

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